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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/031,875   | 05/14/2002  | Jay A Fournier       | 021238-503          | 8681             |
| 21839  | 7590        | 11/01/2005           | EXAMINER            |                  |
| BUCHANAN INGERSOLL PC<br>(INCLUDING BURNS, DOANE, SWECKER & MATHIS)<br>POST OFFICE BOX 1404<br>ALEXANDRIA, VA 22313-1404 |             |                      | MAYES, DIONNE WALLS |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1731                |                  |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,875

Applicant(s)

FOURNIER ET AL.

Examiner

Dionne Walls Mayes

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-18,20,22,23,25,26 and 29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 25 and 29 is/are allowed.  
6) ☐ Claim(s) 2-14,16-18,20,22 and 26 is/are rejected.  
7) ☒ Claim(s) 15 and 23 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The indicated allowability of claims 4,13, and 16-17 is withdrawn in view of the newly discovered reference(s) to Allan. Rejections based on the newly cited reference(s) follow.

#### ***Priority***

1. It appears that Applicant has made a foreign priority claim, under 35 USC 119(a)-(d); however, such a claim cannot be based on a US Application – which appears to be the case (09/361988 filed on 7/28/1999 and 09/399,159 filed on 9/20/1999). Please make the necessary corrections to file wrapper and specification. Also, see MPEP 1893.03(c) which discusses priority claims under 35 USC 120.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 2-3, 5-12, 14, 18, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US. Pat. No. 5,060,6784).

Brown et al discloses nearly all that is recited in the claims (see entire document, specifically col. 3, lines 31, and 59-62; and col. 9, lines 33-37) since it discloses a cigarette having a wrapper which includes a burn modifier up to 15% (which may comprise one or more chemicals), in addition to other compounds, to result in a cigarette having a reduced amount of sidestream smoke. Monoammonium phosphate is the preferred burn modifier, but also included is potassium or sodium citrate. The Examiner construes the monoammonium phosphate burn modifier as corresponding to the claimed ammonium-containing “filler”, since, as one having ordinary skill in the art would have known that such a modifier can be added to the papermaking furnish to

Art Unit: 1731

affect the properties of the resulting cigarette wrapper (which is the purpose/function of a "filler"). While there may be no specific articulation, in Brown et al, that said ammonium-containing compound is provided in an amount effective to reduce aldehyde content, the Examiner believes that this is obviously the case. First, Brown et al states that the particular paper compositions of its invention function by avoiding the production of aldehydes during smolder of the cigarette (see col. 3, lines 59-62). This suggests that the various additives, including the burn modifier, act to reduce the content of aldehyde in the cigarette smoke. Even though Brown et al may not mention that it is the monoammonium phosphate that reduces the aldehyde content, it follows that this compound would effectuate this result to some extent since it is well - known/evident that when heated at temperatures reached during smoking, ammonium salts release ammonia gas (in addition to carbon dioxide and water), which then would reduce the level of aldehyde in the cigarette smoke by chemical reaction. (This theory is even clear from Applicant's Table 1 on page 8 of the instant specification). Therefore, it follows that the monoammonium phosphate would contribute to the reduction of the aldehyde content in the smoke generated by the cigarette of Brown et al.

3. Claims 2-6,12-14,16-17, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allan (US. Pat. No. 5,096,539).

Allan discloses a paper sheet comprised of cellulosic fibers (i.e. wood pulp) having either manganese ammonium phosphate or magnesium ammonium phosphate (or both) as fillers, in an amount ranging from 1-40% (see entire document). While not specifically articulated as such, the paper of Allan is capable of being used as a wrapper

Art Unit: 1731

for a smoking article. Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

Regarding claim 16, it would have been obvious to one having ordinary skill in the art at the time of the invention to have had the claimed mineral phase and any of these phases are common forms of the ammonium compound.

#### ***Allowable Subject Matter***

4. Claims 15 and 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 25 and 29 are allowed.

#### ***Response to Arguments***

6. Applicant's arguments filed 8/12/05 have been fully considered but they are not persuasive.

- Applicant argues that Brown does not disclose or suggest a wrapper for a smoking article of an electrical smoking system; however, the Examiner contends that Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In

Art Unit: 1731

other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

- Applicant also argues that Brown does not teach or suggest an ammonium-containing compound filler in an amount effective to reduce aldehyde content in the mainstream smoke, and Examiner's statement that "when heated at temperatures reached during smoking, ammonium salts release ammonia gas ...which then reduce the level of aldehyde in the cigarette smoke by chemical reaction..." is not based on teaching in the prior art. However, the Examiner disagrees and directs Applicant's attention to Shafer et al (US. Pat. No. 6701936) – which states that Ammonium salts reduce the level of formaldehyde in cigarette smoke by reaction (col. 5, lines 23-24).

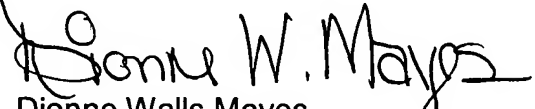
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

October 31, 2005